

Serial No. 09//804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003**REMARKS/ARGUMENTS**

Applicants' invention is set forth in the pending claims.

In the outstanding Official Action, the Examiner continues to indicate allowance of claims 2, 4, 5, 9 and 10. Such allowance is noted with appreciation.

However, the Official Action is inconsistent in rejecting remaining claims 1, 3 and 6-8 and such inconsistency makes it impossible to respond thereto.

Accordingly, it is respectfully requested that for the reasons set forth hereinbelow, an amended and corrected Action be provided, free of ambiguity and permitting applicant an appropriate opportunity to respond thereto.

Moreover, as also shown herein, the rejections are erroneous on the merits thereof.

Therefore, it is courteously submitted that upon providing a further Action in response to the present request, each of the rejected claims should be indicated as allowed, unless the Examiner discovers and applies additional reference(s).

a) The Action Includes Inconsistent Assertions And Cumulative Rejections

1. The Action inconsistently rejects claims 1, 3 and 6, and dependent claims 7-8, under 35 USC 102 over Shin-Chin '858 and under 35 USC 103 over the *same '858 reference* in view of Wolfe '833. As such, applicant is placed in an untenable position of not knowing whether the Office, acting through the Examiner, is or is not asserting that '858 discloses the entirety of the recitation of the rejected claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

Serial No. 09//804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003

prior art reference.”. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), as quoted at MPEP §2131. If the rejection under 35 USC 102 is intended and is proper, then the ‘833 reference is superfluous and cumulative and, as such, need not be considered in applicant’s response. On the other hand, if the rejection under 35 USC 103 is intended and is proper, then it is quite clear that the ‘858 reference does not disclose each and every one of the limitations of the rejected claims so that, appropriately, applicant need not address the issue of anticipation. Therefore, in order to be able to exercise the due process to which he is entitled, applicant courteously submits that the inconsistency in rejection requires correction, that such correction be provided in the form of a new action which clearly identifies the grounds for rejection of the claims, and that an appropriately restarted period be provided for response thereto.

2. Each of the rejected independent claims 1, 3 and 6 includes a recitation that a base which supports the motor in a frame is “supported at the central portion of the frame by stays” (or by means of stays). As defined in the paragraph beginning at col. 3, line 65 of the ‘858 reference, however, element 91 therein is a “safety guard” for the fan blades 89, and not “stays” which support the base 93, defined in the reference as “a motor housing”.

3. The Examiner appears to recognize this deficiency, and (at the last two lines of page 5 of the action) admits that the ‘858 reference “does not disclose the base (93) supported {directly} at the central portion of the frame by stays 91.” The Action thus rejects the claims under 35 USC 103 over ‘858 in view of ‘833.

Serial No. 09//804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003

4. On the other hand, the Action also includes a rejection of claims 1, 3 and 6-8 under 35 USC 102 over the '858 reference alone.

5. Accordingly, by its own admission at page 5, the action states that there is no basis for rejection of claims 1, 3 and 6-8 under 35 USC 102 since such a rejection can only be based on a reference which discloses each and every one of the limitations of the claim(s) rejected thereover.

6. The rejection of claims 1, 3 and 6-8 under 35 USC 102 over the '858 reference is thus inconsistent with the Examiner's own observations and fails to provide applicant with the basis for rejection of the claims. Either the '858 reference discloses each feature of the rejected claims, or it does not. The assertions on the one hand that it does, and on the other that it does not, are inconsistent, fail to convey the position of the Office, and fail to provide applicant a proper opportunity to respond thereto.

7. MPEP §706.02 provides that "Prior art rejections should ordinarily be confined strictly to the best available art." However, the outstanding Action fails to identify whether the best available art is the '858 reference alone or the '858 reference combined with '833. An exception to this requirement is provided in the event that the propriety of a rejection under 35 USC 102 or 103 "depends on a particular interpretation of a claim". However, the Manual nonetheless cautions that "Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided." In the present instance, if the primary rejection in the Action (under 35 USC 103) fails, then quite clearly

Serial No. 09//804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003

the rejection under 35 USC 102 would also fall. Accordingly, the Action improperly includes prohibited cumulative rejections and requires correction.

8. Therefore, a corrected Action is in order withdrawing at least one of the pending rejections and restarting the period for response.

b) The Action Ignores Clear Distinctions Between the Claims and the Art Which, Even if Combined, Fails to Teach or Suggest Applicant's Claims

The following remarks further note that the rejections are improper in view of clear distinctions between the art and the claims, and thus that any corrected action must withdraw both pending rejections.

1. Each rejected claim includes a recitation of a chamber "forming a body with a closed end" (claims 1, 6) or "forming a cylindrical body with a closed end" (claim 3). This feature is shown with reference to Figs. 3-4 for example, wherein the front end (left side of drawings) of sealed chamber 11 is formed of a closed cylindrical body formed of flange 4a. However, nowhere does the rejection address this limitation and nowhere does the action identify any teaching of such a closed end. Indeed, as is quite clear from Figs 8 and 10 of the '858 reference, back wall 99 of housing 93 has a front *opening*, and thus is *not a closed end*. The secondary '833 reference fails to address or cure this deficiency. Therefore, whether considering the '858 reference alone or the combination of references, one of ordinary skill would neither have been put in possession of the claimed

Serial No. 09/804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003

invention nor would have been given a suggestion for successful implementation of a structure with a closed end.

2. Each rejected claim requires the structure to have a back portion of the chamber which is "sealed by a removable cover" (claim 1) or a rear opening of the base which is "occluded by [a] cover detachably mounted by screws on the base" (claims 3 and 6). This is illustrated by cover 10 in Fig. 3, for example, which seals and occludes the cylindrical body of flange 4a forming the chamber. However, the '858 reference fails to teach any such sealing or occlusion of the chamber or opening. Instead, the removable cover 105 identified by the Examiner is described in the paragraph beginning at column 4, line 6 of the reference as "a cap" for the switch 103 and stem 106 thereof. Indeed, in the only structural or functional description of the cap found in the specification, the cap is identified as follows. "Cap 105 is mounted on stem 106 and is sized so as to completely cover body portion 104 and thereby prevent exposure thereof." Accordingly, the cap is disclosed merely as being sized to cover the switch body 104, but is nowhere disclosed or suggested as being sized to seal the chamber formed for the switch. The secondary reference fails to address or cure this deficiency. Therefore, whether considering the '858 reference alone or the combination of references, one of ordinary skill would neither have been put in possession of the claimed invention nor would have been given a suggestion for successful implementation of a structure having a chamber for electrical components and which is sealed or occluded by a removable cover.

Serial No. 09//804,198

Response Dated March 3, 2004
Reply to Action Dated October 3, 2003

3. Still further, it is noted that claims 3 and 6 each recite that the cover occluding the rear opening is "detachably mounted by screws", as illustrated at 9 in Figs. 3 and 4, for example. On the other hand, as disclosed in the '858 reference, cap 105 is merely mounted on stem 106 of switch 103, and is neither attached to the base (or housing) nor mounted by screws thereto. The only screws disclosed in the reference are provided for mounting of the switch 103 to the housing. As noted at col. 4, lines 10-13, "Body portion 104 is mounted on a pair of seats 107 formed in an opening 108 in back wall 99 of motor housing 93 and is secured thereto by screws 110". Then, at lines 16-17 the reference discloses that "Seats 105 are formed in back wall 99 and are secured thereto by screws 106." It is apparently intended to state that "Seats 107 are formed in back wall 99 and are secured thereto by screws 110." In any case, it is clear that the '858 reference fails to teach or suggest that the cover, or cap, be attached to the housing by screws and it is similarly clear that the secondary reference fails to address or cure this deficiency. Therefore, whether considering the '858 reference alone or the combination of references, one of ordinary skill would neither have been put in possession of the claimed invention nor would have been given a suggestion for successful implementation of a structure having a chamber for electrical components and in which a removable cover is attached by screws to seal or occlude the chamber.

Serial No. 09//804,198

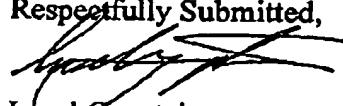
Response Dated March 3, 2004
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It is thus respectfully submitted that, without delving into any additional distinctions, the foregoing demonstrates the impropriety of rejecting any of claims 1, 3 or 6-8 over either the '858 reference alone or the combination of '858 and '833 references, as the individual reference fails to anticipate the claims and the combination of references fails to meet the requirement for making a *prima facie* showing of obviousness under 35 USC 103.

Therefore, it is courteously submitted that a corrected action, as requested in order to cure the deficiencies of inconsistent rejections noted at pages 2-5 herein, should reconsider and eliminate both grounds for rejection since neither grounds supports rejection of the claims.

In view of the foregoing, it is respectfully submitted that whether or not a corrected Action is provided, the pending claims of the application are patentable over the applied art and an early indication of the same is courteously solicited. In order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, the Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number if any further comments, questions or suggestions arise in connection with the application.

Respectfully Submitted,


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